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TASER INTERNATIONAL, INC.
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EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 20-25 directed to an invention that is independent or distinct from the invention originally elected and claimed for the following reasons: the inventions are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of using that product such as in the process of holding a flashlight.

Since applicant has received an action on the merits for the originally presented and elected invention, claims 20-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. February

Drawings

2. The drawings were received on 10/5/06. These drawings are acceptable.

Response to Arguments

3. Applicant's arguments filed 10/5/06 have been fully considered but they are not persuasive. With regards to applicant's contention that the amendments to the specification have overcome the objections to the specification as failing to provide proper antecedent basis for the claimed subject matter, it is noted that *every* term of the claims must find support in the specification. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with

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clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. The claim terms “first means”, “second means”, “first member” and “second member” do not have proper antecedent basis in the specification. Furthermore, where the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-plus-function, applicant must **clarify the disclosure** to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim elements and equivalents thereof. (See MPEP 2181). Correction of the following is required: applicant must clarify the disclosure to **explicitly state**, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the means for mechanically coupling, means for coupling and means for separating recited in the claim elements and equivalents thereof. In response to applicant’s remarks concerning the limitations of intended use, it is noted that the claims are directed to a support intended to be used to attach a non-lethal implement to a firearm. The claims are directed to the support only and neither the implement nor the firearm is currently positively recited in the claims. It is the structure not the intended use of the structure (i.e. what a device is not what a device does) that must distinguish the present apparatus from the prior art. The prior art apparatus anticipates the claimed apparatus if the prior art apparatus teaches all the structural limitations of the claims, the prior art and the prior art has the *ability* to perform the function recited in the present claims. For example it is irrelevant that the “first channel” of the present application is intended to receive a rail of a firearm *that is not currently being claimed*, as long as the prior art discloses a channel that has the ability to receive a rail of a firearm, the prior art

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anticipates the claimed device. With regards to applicants remaining arguments concerning the art rejections, applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claim terms “first means”, “second means”, “first member” and “second member” do not have proper antecedent basis in the specification. Furthermore, where the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-plus-function, applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim elements and equivalents thereof. (See MPEP 2181). Correction of the following is required: applicant must clarify the disclosure **to explicitly state**, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the first means for coupling and second means for coupling recited in the claim elements and equivalents thereof.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has claimed a support for attaching a non-lethal implement to a firearm but without positively reciting the implement. Yet claim 10 further recites that the

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implement delivers a non-lethal force comprising electromuscular stimulation and claim 14 further recites limitations concerning the implement as if it were positively being claimed. The claims are indefinite in that it is not clear whether applicant is claiming the support only or claiming the combination of the support with the implement since applicant further claims limitations of the implement. For the remainder of this action it will be assumed that applicant is claiming the support only and that applicant only **intends** the support **to be used** with the implement recited in the claims 10 and 14 and applicant is not actually claiming the combination of the support and the implement, in which case applicant is directed to the statements regarding recitations of intended use located in the present and previous office action.

7. Regarding claim 6, the word "means" is preceded by the word(s) "first" and "second" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-7, 18 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Matthews et al. (US Patent # 6,378,237). Matthews et al. discloses a support that *has the ability to be used to attach a non-lethal implement to a firearm that has a picatinny rail and a stop that is*

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not part of the rail (it is noted that nearly any implement can be considered non-lethal), the support comprising: a track and slide combination (reference 17) (i.e. first means for coupling the non-lethal implement to the rail) and clamping device (reference 104) (i.e. second means for coupling the non-lethal implement to the stop) that has the ability to reduce motion of a non-lethal implement along the rail parallel to a direction of delivery of a lethal force of the firearm. The first means is "adapted to" or has the *ability to* couple to a picatinny rail and the second means is "adapted to" or has the *ability to* couple to a sight. While it is acknowledged that Matthews et al. does not expressly disclose the second means actually coupled to a sight it is noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires *the ability to so perform* and the second means of Matthews et al. has the ability to couple to a sight. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Furthermore it is noted that the [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses; c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

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Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

With regards to claims 18 and 19 Matthews et al. discloses a support that *has the ability to be* used to attach a non-lethal implement to a firearm that has a rail and a stop that is not part of the rail (it is noted that nearly any implement can be considered non-lethal), the support comprising: a first member, a second member coupled to the first member to form an assembly that *has the ability to hold an implement between the first member and the second member*, the assembly having a channel that *has the ability to receive the rail and a fastener that restricts motion of the assembly with respect to the stop thereby restricting sliding of the channel with respect to the rail, wherein the fastener is manually releasable without using a tool* (See examiner's notes on Figure 2).

9. Claims 6 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Oz (US Patent # 6,854,206). Oz discloses a support that *has the ability to be used to attach any implement including a non-lethal implement (it is noted that nearly any implement can be considered non-lethal) to a firearm that has a rail and a stop that is not part of the rail, the support comprising: a first means for coupling the non-lethal implement to the rail* (See embodiments 4-6, since applicant's disclosure has not explicitly stated what applicant considers the "first means" and equivalents thereof, thereby not properly invoking 112 ¶ 6 means plus function language, any structure that is capable of performing the function of the claim anticipates the claimed device), *second means for coupling the non-lethal implement to the stop that has the ability to reduce motion of a non-lethal implement along the rail parallel to a direction of delivery of a lethal force*

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of the firearm. Wherein the second means is "adapted for" or has the ability for coupling to a sight that includes the stop.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teetzel (US Patent # 5,584,137) in view of Matthews et al. (US Patent # 6,378,237). Teetzel discloses a support that *has the ability to* be used to attach a non-lethal implement to a firearm that has a picatinny rail and a stop that is not part of the rail (it is noted that nearly any implement can be considered non-lethal), the support comprising: a contour surface (reference 72) (i.e. a first channel that has the ability to receive the rail to mechanically couple a non-lethal implement and the rail), a surface that abuts the trigger guard (best seen in Figure 6) (i.e. a first abutment surface), a second channel (the channels of the rail portions of or for part 10) that *has the ability to* receive a non-lethal implement and a second fastener (reference 19) having *the ability to* retain that non-lethal implement in the second channel. The second channel is "adapted to" or *has the ability to* receive any implement that has corresponding construction for attaching including an implement that delivers a non-lethal force comprising electromuscular stimulation and the first channel is "adapted to" or *has the ability to* receive a picatinny rail. While it is acknowledged that Teetzel does not expressly disclose the second channel actually receiving a implement that delivers a non-lethal force comprising electromuscular stimulation it is noted that it has been held that the

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recitation that an element is “adapted to” perform a function is not a positive limitation but only requires *the ability to so perform* and the second channel of Teetzel *has the ability to receive* such an implement. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. At least one of the first fastener and second fastener is manually releasable without using a tool and by manually accomplishing a rotary motion of a portion of the fastener to an extent less than 720 degrees (reference 19). A non-lethal implement would have the ability to deliver non-lethal force from a front end of the non-lethal implement (such as the non-lethal implement shown by Matthews et al.), the second channel comprises a second abutment surface that faces a rear surface of the non-lethal implement (at figure 3A the surface of the L shaped structure near reference number 21). The support further comprises a first portion and a second portion and the second fastener mechanically joins the first portion of the support to the second portion of the support. Although Teetzel does not expressly disclose the first abutment surface and clamping fasteners (references 108-111) (i.e. a first fastener) that cooperate in a manner having the ability to confine a stop therebetween, Matthews et al. does. Matthews et al. teaches a support that *has the ability to* be used to attach a non-lethal implement to a firearm that has a rail and a stop that is not part of the rail, the support comprising: a first channel that receives the rail and a first abutment surface and a first fastener that cooperate to confine a stop of a firearm therebetween (i.e. clamp device 104). The support further comprises a first portion and a second portion and the first fastener mechanically joins the first portion of the support to the second portion of the support. Matthews et al. and Teetzel are analogous art because they are from the same field of endeavor: mounts for firearms. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the clamping device as suggested by

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Matthews et al. with the mounting device as disclosed by Teetzel. The suggestion/motivation for doing so would have been to obtain a mount for a firearm that was assured positional stability as suggested by Matthews et al. (column 3, lines 55-60). The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

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Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

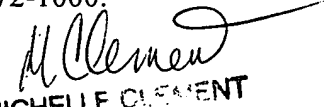
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MICHELLE CLEMENT
PRIMARY EXAMINER

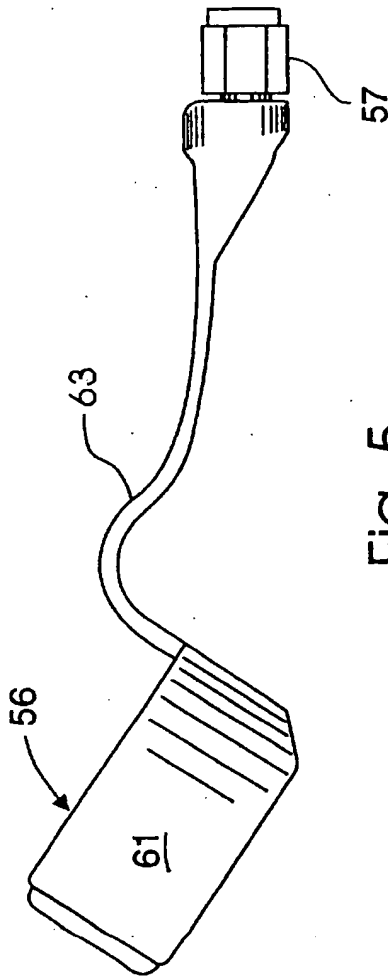


Fig. 5

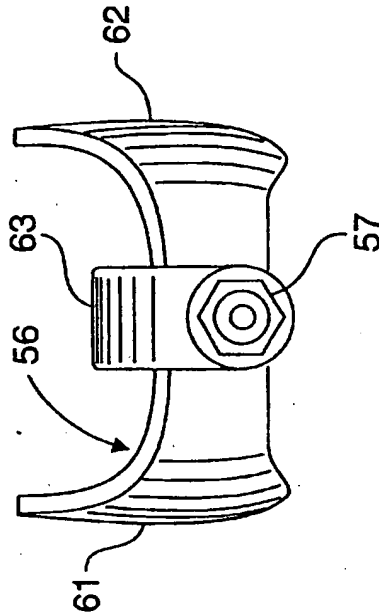


Fig. 6

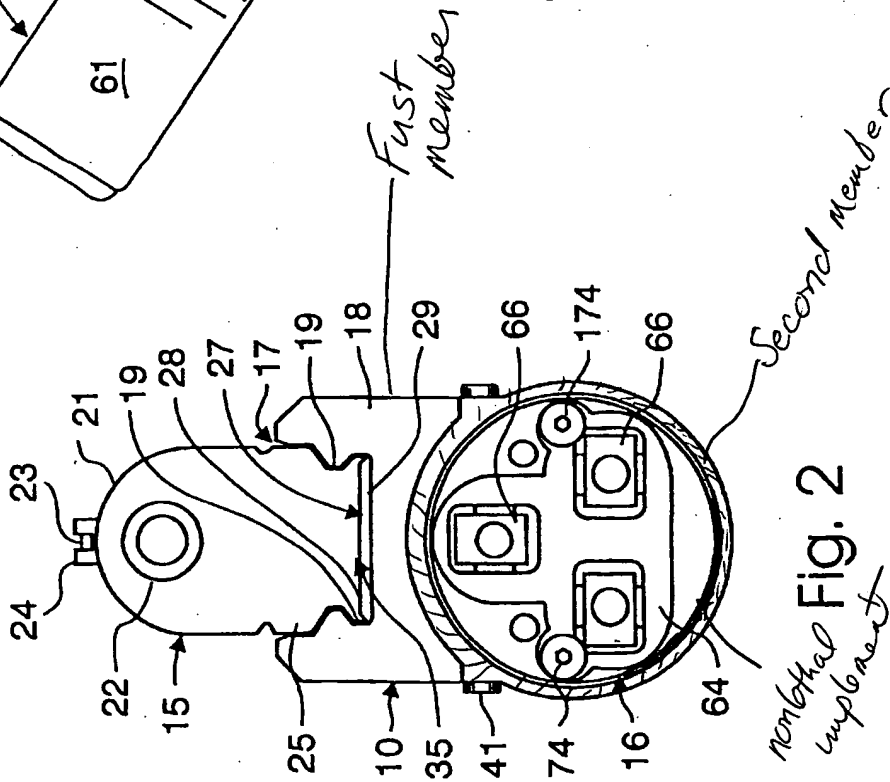


Fig. 2

Fast member

Second member

Nonbthal implement